

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-PIERRE GLOTON
and PHILLIPE PERES

Appeal No. 97-0819
Application 08/252,063¹

ON BRIEF

Before GARRIS, WARREN and WALTZ, *Administrative Patent Judges*.
WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 28. Claims 1 through 9 were subsequently allowed by the examiner, leaving claims 10 through 28 for our consideration on appeal. Claims 10 and 21 are illustrative of the claims on appeal:

10. An electronic component support for a memory card which has a cavity to house said component, said support

¹ Application for patent filed June 1, 1994. According to appellants, this application is a continuation of application 07/919,047, filed July 23, 1992, which is a reissue of U.S. Patent No. 4,943,464, maturing from application 07/278,979, filed December 1, 1988.

comprising a first silicon base, one side of which is used as the substrate for the manufacture of the different elements of the electronic component, and comprising a second based made of a material having a greater mechanical strength than silicon, which is fixed to the other side of said first base, the second base being fixed to a film which acts as an element to close the cavity.

21. An electronic component support module for a memory card having a cavity to house an electronic component, said

support module comprising:
a chip having an electronic component manufactured on a first side of said chip;
a material having a greater mechanical strength than silicon
on a second side of said chip, opposite to said first

side;
a resin material encapsulating exposed surfaces of said electronic component and said material having a greater
mechanical strength than silicon;
wherein said electronic component support module has a thickness not exceeding about 600 microns.

The appealed claims as represented by claims 10 and 21 are drawn to a "support" or "support module" for electronic components for "memory" cards, which "support" or "support module" is characterized as having a layer or "base" which is "made of a material having a greater mechanical strength than silicon."

The examiner has rejected the appealed claims under 35 U.S.C. § 112, first paragraph, enablement, in three groups: appealed claims 10, 17 through 19, 21, 22 and 28; appealed claims 10 through 27; and, appealed claims 21 and 23 through 28.² We reverse.

² The other two grounds of rejection, i.e., "Issue 1" and "Issue 3" (answer, pages 3-4) were withdrawn by the examiner (answer, page 4, and supplemental answer, page 1).

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer³ and to appellants' brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find that we cannot agree with the examiner that appealed claims 10 through 28 violate the provisions of 35 U.S.C. § 112, first paragraph, with respect to enablement.

It is well settled that the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification is in doubt, including reasons why the description of the invention in the specification would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation, in order to establish a *prima facie* case under the enablement requirement of the first paragraph of § 112. *In re Wright*, 999 F.2d 1557, 1563, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). Based on the record before us, the examiner has not made out the required *prima facie* case.

We first consider the examiner's contentions with respect to the meaning of the claim term "mechanical strength" (answer, page 9), which issue of definiteness we must resolve

³ The examiner's supplemental answer does not pertain to the ground of rejection maintained on appeal.

before considering the issues raised by the examiner under § 112, first paragraph. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In doing so, we find that even if the term "mechanical strength" is not a term of this art area, and we believe that it is, the disclosure of the concepts of "mechanical strength" as well as "mechanical damage" at col. 1, line 64, to col. 2, line 18, of appellants' specification along with the examples of materials having "greater mechanical strength than silicon" provided therein at col. 3, lines 2-7, would clearly convey to one skilled in this art the concept of "mechanical strength." Thus, we are of the view that one skilled in this art would reasonably understand the subject matter claimed through the use of this term. *The Beachcombers, Int'l. v. WildeWood Creative Prods.*, 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986); *Moore*, supra.

Turning now to the enablement issues, we fail to find in the record any reasonable explanation why one skilled in this complex art area would be unable to practice the invention as claimed without undue experimentation. Indeed, we find no reason in the record why one of ordinary skill in this art would even find it difficult to determine which "materials have a greater mechanical strength than silicon," the "thickness" at which these materials may be used with respect to any particular memory card, which cards are of no *standard* depth, or the material which may be used for the "chip" serving as a component of the support and the support module.

We observe that the examiner's contentions are more akin to the written description requirement than the enablement requirement of § 112, first paragraph. We point out that claims may satisfy the enablement requirement but not the written description requirement of this section. See *In re Ahlbrecht*, 435 F.2d 908, 911, 168 USPQ 293, 296 (CCPA 1971). However, the arguments as advanced by the examiner do not, *prima facie*, establish that, as a factual matter, the claimed invention was not adequately described to one of ordinary skill in this art by the disclosure in the specification at the time the application was filed. See *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Wertheim*, 541 F.2d 257, 262, 264, 191 USPQ 90, 96, 98 (CCPA 1976).

The examiner's decision is reversed.

Reversed

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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THOMAS A. WALTZ)
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